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EXAMINER				
CASLER, TRACI				
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3629				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/826,690

Applicant(s)

HARBAUGH, JOSEPH

Examiner

Traci L. Casler

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to papers filed on February 19, 2008.

Claim 25 has been amended.

Claims 23-44 are pending.

Claims 23-44 are rejected.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 23-44 rejected under 35 U.S.C. 103(a) as being unpatentable over New York Times article, "Opponents of Change in CUNY Admissions Policy Helped Pass a Compromise Plan.", Nov. 24, 199, Arenson, Karen; Hereinafter referred to as CUNY in view of www.gradcollege.stw.edu retrieved from the archive.org any linkage February 29, 2000.
3. As to claims 23, 43 and 44 CUNY teaches offering a program for admissions to the graduate school that includes an abbreviated academic program(Pg. 2 ¶ 8). Subjecting test takers to a test during the examination .program(PG. 2 ¶ 7) Admitting student to the graduate program who achieve a satisfactory score(Pg. 2 ¶ 8). CUNY fails to teach calibrated grading and identifying the students who have not applied to the school. Calibrated Grading is an old and well known process of grading examination to promote fairness as noted by applicants affidavits submitted August 24, 2005, therefore

it would have been obvious to use such a well known system when testing individuals against each other. As to identifying students who have not applied grad college identifies students who have not. applied, it would have been obvious to combine this ' will CUNY As to the limitation getting a pool of standardized test takers the examiner takes official notice that it is old and well known in the art of admissions to purchase or gain access to a list of students in a particular category in order to target enrollment. The examiner draws on her experience as an admissions counselor from August 1999 to May 2004 that colleges and universities routinely purchase student names and test scores from testing organizations such as SAT in order identify students in an academic/testing category in which the school wishes to target enrollment. This practice was taking place long before the examiner was in the field in 1999. Therefore it would have been obvious to use a test taking pool batch for identifying new admits targeted for enrollment. CUNY fails to teach the method being applied to a grad school versus an undergraduate program. Grad college teaches a conditional admission process for a graduate school. It would have been obvious to one skilled in the art at the time of invention to combine Grad college with CUNY as success in one level of education would warrant a one to try this approach in a different level.

4. As to claim 24 CUNY teaches remedial courses (Pg. 2 ¶ 9). 11.
5. As to claim 25 CUNY teaches a predetermined test score(Pg. 2 ¶ 79). Although, CUNY fails to teach the test score that is correlated to academic success the examiner notes it would have been obvious to one of skill in the art to use any type of scoring that would demonstrate the student's ability to be successful. Furthermore, the type of test

used in determine the student's skill does not produce a function in the method, the function is based off the score of the test not the exact test itself.

6. As to claim 26-27 CUNY teaches an abbreviated program(Pg. 2 ¶ 7). The examiner note the specific duration of the program is non-functional descriptive material. As the duration of the program is not used in any further determination for the program. These differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps would be performed regardless-of the duration of the program. "Thus; this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see in re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401,44(Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir. 1994).

7. As to claim 28-29 Grad college teaches the GRE verbal and written. (Pg. 7 I. 10-14). It would have been obvious to one skilled in the art to combine Grad college with CUNY as there are different levels of standardized testing for the specific levels of schooling.

8. As to claims 31-36 CUNY teaches instructing the students. As to the method of which the student is taught, either synchronous, asynchronous and online or in-person are non-functional descriptive material. These differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps would be performed regardless of the type of instruction being provided.. Thus, this descriptive material will not distinguish the claimed invention from the prior art

in terms of patentability, see *in re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 44(Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir. 1994).

9. As to claim 37 CUNY teaches an abbreviated academic program, however CUNY does not teach a program for Law School. It would have been obvious to combine CUNY with law school. If one sees success in one area of education it would be obvious to try the same method at a different level with reasonable expectations of success and predictable results. See Supreme Court Decision KSR.

10. As to claims 30,38-41 CUNY teaches a method for admitting students who do not have the grades and test scores for regular admissions. CUNY fails to teach a shifting range for test scores and GPA's. Grad College teaches a shifting system based on GRE and GPA(Pg. 7 I. 5-25). It would have been obvious to one skilled in the art to combine Grad College with CUNY so as to find a balance for students who test well but average grades or don't test well and have great grades.

11. As to 42 CUNY teaches a method for admitting students who do not have the grades and test scores for regular admissions but fails to teach a calibrated grading system. However, the calibrated grading system is old and well known to those in the arena of examination grading.

Response to Arguments

12. Applicant's arguments, see Pg. 9-19 filed February 19, 2008, with respect to the 35 USC 102(b) rejections and the first 35 USC 103 rejection have been fully considered and are persuasive. The rejection of these has been withdrawn.

13. Applicant's arguments filed February 19, 2008, with respect to the 35 USC 103 rejection of claims 23-44 with respect to CUNY and Grad College references have been fully considered but they are not persuasive.

14. The applicant argues that the references fail to teach certain aspects of the claimed invention.

15. A) offering a program for admission to test takers who have not applied for admission B) offering a program for admission to test takers who have not applied for admission and who possess GPA's and standardized test scores that are insufficient to gain regular admission. The examiner notes the a reference has been supplied to support the examiner taking official notice with respect to identifying students who possess the scores in which a university/college wishes to target students for admission. Additionally, the students are "offered" admission but would still be required to submit an application to be admitted, the aspect of the invention is not any different than any admissions program. A student is not "admitted" to a university unless they actually apply. Collegeboard.com shows that higher education institutions have been targeting students within pre-defined education status for years in order to get them to apply and increase the institutions enrollment.

16. C) Calibrated grading for examinations. The applicant himself has submitted an affidavit of one skilled in the art that calibrated grading is old and well known in the art, therefore, the affidavit supports that it is known and would have been obvious to combine.

17. D) Offering a program for admission consisting of abbreviated academic program that the test takers may participate in without a personal recommendation from a graduate advisor. The examiner first notes the limitation "without a personal recommendation from a graduate advisor" is not a limitation that is claimed, nor does the applicant have support for such a negative limitation. Additionally, the applicant argues that the abbreviated program of 5-7 weeks returned unexpected results. However, the applicant has failed to provide the results and the degree to which they different from a non-abbreviated program. This result was persuasive of nonobviousness even though the result was equal to that of one component alone. Evidence of a greater than expected result may also be shown by demonstrating an effect which is greater than the sum of each of the effects taken separately (i.e., demonstrating "synergism"). *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). However, a greater than additive effect is not necessarily sufficient to overcome a prima facie case of obviousness because such an effect can either be expected or unexpected. Applicants must further show that the results were greater than those which would have been expected from the prior art to an unobvious extent, and that the results are of a significant, practical advantage. *Ex parte The NutraSweet Co.*, 19 USPQ2d 1586 (Bd. Pat. App. & Inter. 1991) (Evidence showing greater than additive sweetness resulting from the claimed mixture of saccharin and L-aspartyl-L-phenylalanine was not sufficient to outweigh the evidence of obviousness because the teachings of the prior art lead to a

general expectation of greater than additive sweetening effects when using mixtures of synthetic sweeteners.). 716.02 Allegations of Unexpected Results

18. Any differences between the claimed invention and the prior art may be expected to result in some differences in properties. The issue is whether the properties differ to such an extent that the difference is really unexpected. In *re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) (differences in sedative and anticholinergic effects between prior art and claimed antidepressants were not unexpected). In *re Waymouth*, 499 F.2d 1273, 1276, 182 USPQ 290, 293 (CCPA 1974), the court held that unexpected results for a claimed range as compared with the range disclosed in the prior art had been shown by a demonstration of “a marked improvement, over the results achieved under other ratios, as to be classified as a difference in kind, rather than one of degree.” Compare *In re Wagner*, 371 F.2d 877, 884, 152 USPQ 552, 560 (CCPA 1967) (differences in properties cannot be disregarded on the ground they are differences in degree rather than in kind); *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992) (“we generally consider a discussion of results in terms of differences in degree’ as compared to differences in kind’ . . . to have very little meaning in a relevant legal sense”)

19. The applicant further argues that the CUNY reference teaches away from the combination relied upon in the rejection. A prior art reference that “teaches away” from the claimed invention is a significant factor to be considered in determining obviousness; however, “the nature of the teaching is highly relevant and must be weighed in substance. A known or obvious composition does not become patentable

simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (Claims were directed to an epoxy resin based printed circuit material. A prior art reference disclosed a polyester-imide resin based printed circuit material, and taught that although epoxy resin based materials have acceptable stability and some degree of flexibility, they are inferior to polyester-imide resin based materials. The court held the claims would have been obvious over the prior art because the reference taught epoxy resin based material was useful for applicant's purpose, applicant did not distinguish the claimed epoxy from the prior art epoxy, and applicant asserted no discovery beyond what was known to the art.). Furthermore, "the prior art's =mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2). The applicant argues because the CUNY reference was established to solve a problem derived in a transitional period at the university it is deemed to teach away. As stated above, the fact that a reference has been described in an "inferior" manner does not constitute patentability of the instant application. Furthermore, in order to teach away, the invention must state be shown to only work in one manner and the combination would not work. The applicant has failed to supply any evidence to the contrary.

20. Additionally, the applicant has argued that there is no motivation to combine the CUNY reference with the Grad College reference because CUNY is used for a transition

period. However, that alone is support to motivate one skilled in the art at the time of invention, CUNY instituted this program to get students who would not meet the new admissions standards prepared and up to the level in which they qualify or are capable of being successful as those students who met the new admissions standards.

21. The applicant additionally argues that "administrators of graduated schools requires that test takers possess certain skills and knowledge prior to admitting them to the graduated school", (Pg 21 2nd full paragraph), as opposed to undergraduate administrators. However, on Pg. 23 1st full paragraph the applicant admits Grad College conditional admission program admits students "who do not meet GPA and GRE requirements". This is contrary to what the applicant earlier alleged on the previous page. The applicant argues that Grad College additionally requires the graduate advisor " However, the applicant at this point is arguing the reference in Piecemeal, this aspect of the invention is not being relied on for the rejection. The reference does not detail what the "graduate advisor" recommendation constitutes. For comparison sake, the applicant's invention "identifies" students who do not possess the minimum requirements for admission and "offer" a conditional admission program. In the Grad College reference, the advisor, identifies the student who does not possess the GPA or test scores but possesses the skills to be successful and therefore recommends conditional admission and offers the conditional admission to the student. Furthermore, applicant's invention does not claim the limitation of "automatically" enroll the students in the "conditional admissions program". They are offered a program but would have to apply and accept the program.

22. As to applicants request to a reference of the identifying test takers with GPA's and test scores of the targeted enrollment group. The examiner has supplied the reference retrieved via the archive.org of www.collegeboard.com, in which the reference describes how higher education institutions can purchase names of students who possessed the institution selected categories of GPA, location test scores etc.

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Traci L Casler/
Patent Examiner, Art Unit 3629

/Jonathan Ouellette/
Primary Examiner, Art Unit 3629